

**REMARKS**

Claims 2-27, 31-42, 44-51, 53-58, 60-78, 81-95, 101, 102, 105, 106 and 109-112 are currently pending, although claims 53-57, 60 and 61 have been withdrawn from consideration. Because the withdrawn claims ultimately depend from non-withdrawn claims, Applicant currently intends to seek rejoinder of the withdrawn claims pursuant to MPEP § 821.04 upon indication of allowable subject matter.

The Office Action rejected claims 5-10, 31-35, 37-42, 46, 48-51, 58, 83, 85-88, 91, 101, 111 and 112 under 35 U.S.C. §102 as anticipated by U.S. patent 5,738,841 ("Mellul"); claims 2-4, 11-19, 21-27, 31, 36, 44, 45, 47, 62-72, 74-78, 81, 82, 84, 89, 90, 92-95, 102, 105, 106, 109 and 110 under 35 U.S.C. §103 as obvious over Mellul in view of U.S. patent 5,690,918 ("Jacks"); claims 20 and 73 under 35 U.S.C. §103 as obvious over Mellul, Jacks and JP 63119412 ("JP 412"). In view of the following comments, Applicant respectfully request reconsideration and withdrawal of these rejections.

The pending rejections were raised by the Office three years ago. These rejections were also overcome by Applicant three years ago. Stated another way, the pending rejections are nothing more than recycled rejections which accomplish nothing more than prolonging prosecution in this case.

More specifically, the Office Action dated May 16, 2005, included essentially the same obviousness rejection in which the primary reference was Mellul.<sup>1</sup> As part of that rejection, the Examiner indicated that "Mellul fails to teach dispersant agent. While the reference generally teaches using fillers in the invention, the reference fails

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<sup>1</sup> In fact, the current rejections are even broader in scope in that they omit reliance upon the Fogel reference which was included in the rejections three years ago.

to teach the amount of fillers (inert particulate) used in lipstick composition." (Page 4).

This recognized failure of Mellul directly contradicts the currently pending rejection under 35 U.S.C. §102 in which the Office relies upon an example in Mellul which contains 48% talc. In making the current anticipation rejection, the Office completely ignores the 30% upper limit of inert particles set forth in the claims, as well as the earlier recognition that Mellul does not teach such a 30% upper limit.

For at least this reason, the rejection under 35 U.S.C. §102 is improper and should be withdrawn.

Furthermore, Applicant's Amendment filed November 16, 2005, included arguments explaining that Mellul does not teach or suggest compositions having an inert particulate phase (0.1-30% of the composition), but rather discloses compositions containing either 0% or 48% particulate phase. The Amendment also included arguments that Mellul teaches that non-volatile silicone compounds and volatile silicone compounds are interchangeable. Thus, Mellul does not teach, suggest or recognize the criticality of having a limited particulate phase present and/or the criticality of omitting volatile silicone compounds.

In the subsequent Office Action dated February 9, 2006, the Office withdrew the rejection under 35 U.S.C. §103 based upon Mellul, recognizing that "Mellul also mentions the functional equivalency of the above non-volatile silicone oils with cyclomethicones, which are volatile oils..." (Page 4).

For at least these same reasons, the currently pending rejections based upon Mellul fail. Accordingly, the rejections under 35 U.S.C. §103 is improper and should be withdrawn.

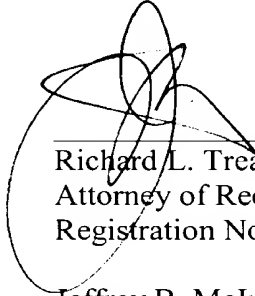
Application No. 09/941,869  
Response to Office Action dated November 18, 2008

Applicant believes that the present application is in condition for allowance.

Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867

Customer Number

**22850**

Tel #: (703) 413-3000  
Fax #: (703) 413-2220